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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,746	12/07/2001	Van Barlow	510P004	8798
7590	05/27/2004		EXAMINER	
Kevin S. Lemack Nields & Lemack 176 E. Main Street Westboro, MA 01581			LOPEZ, MICHELLE	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/017,746	BARLOW ET AL.
	Examiner	Art Unit
	Michelle Lopez	3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 March 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                         |                                                                             |
|-------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.                                               |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                         | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

1. This action is in response to the amendment filed on March 22, 2004.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Kish (US Pat. 5,882,405). Kish'405 discloses a method of forming an insulated staple including the process steps of providing a staple body via wire "12" adapted to be formed into a bight portion and a pair of legs (not shown numerically), providing a uniform coating on the staple body "12" via "14" (see col. 6, lines 34-36 and 62-65) with a dielectric coating applied to an individual wire "12" prior to formation into said bight portion and pair of legs (see Fig. 9), and forming the staple body into the bight portion and the pair of legs via "22" to form an integral unitary structure.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dennis (US Pat. 6,082,604) in view of Kish (US Pat. 5,882,405). Dennis'604 discloses the invention substantially as claimed including a housing "A", a driver "E", an actuator "B", a detachable magazine assembly "100", one or more staples "300", a nose "W", a tail end (see Fig. 1), a pusher "250", a staple bight portion and a pair of legs (see Fig. 20), and a process of fastening a wire or cable to a substrate (see col. 1, lines 8-25). Dennis'604 does not specifically state that the fasteners are uniformly coated forming a unitary structure. However, Kish'405 teaches the process step of uniformly coating a staple body "12" (see Fig. 9) for the purpose of forming a unitary fastener structure coated on its entire exterior surface (see col. 6, lines 34-36 and lines 62-65). In view of Kish'405, at the time the invention was made, it would have been obvious to one having ordinary skills in the art to have provided Dennis' invention with a uniformly coated fastener structure, as the staples body or wires "12" are fed to a coating station with a substantial amount of free space about the periphery of each wire "12", in order to form a unitary fastener structure.

Regarding claim 2 and 6, Dennis'604 does not disclose a coated fastener with an electrically insulating coating. However, as Kish's invention provides an electrostatically coating process with a nylon coating powder, it is deemed that the coating powder is a non-conductive material coated to the fastener for the purpose of providing electrically insulating properties to the fastener. In view of Kish'405, it would be obvious to one having ordinary skill in the art to have provided Dennis' invention including a coated fastener with a nylon coating which provide electrically insulating properties to the

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fastener in order to minimize the possibility that the fastener penetrate or damage the sheathing on a wire and cause an electrical short circuit.

Regarding claim 3, Dennis'604 does not specifically state that the coating has cushioning properties. However, Examiner takes Official Notice of the well-known act of provide Dennis' invention including a fastener having a coating with cushioning properties for the purpose of fastening a staple to a wire without damaging or deforming the wire. It would have been obvious to one having ordinary skill in the art to have provided Dennis' invention including a staple having a coating with cushioning properties in order to attach a staple to a wire without causing damage or deformation of the wire that could create a short circuit or other effects on the electrical current being transmitted.

Regarding claim 5, Dennis'604 does not disclose that the fastener is coated with nylon. However, Kish'405 teaches a fastener coated with nylon for the purpose of providing a unitary structure with a thermoplastic coating. In view of Kish'405, it would have been obvious to one having ordinary skills in the art to have provided Dennis' invention with a fastener coated with nylon in order to provide a unitary structure with a thermoplastic coating, thereby providing insulating properties.

Regarding claims 8-9, Dennis'604 discloses the invention substantially as claimed including a staple "300" for securing a wire to a substrate (see col. 1, lines 11-16) having a bight portion and a pair of legs (see Fig. 20). Dennis'604 does not disclose a dielectric coating coated to a staple body prior to formation into a bight and the pair of legs. However, Kish'405 teaches a dielectric coating coated to staple body prior to formation into a bight and the pair of legs (see col. 1, lines 61-66, and col. 2, lines 16-18) for the

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purpose of forming a unitary structure, wherein the coating remains stationary on the staple. In view of Kish'405, it would have been obvious to one having ordinary skill in the art to have modified Dennis' invention including a dielectric coating coated to staple body prior to formation into a bight and the pair of legs in order to form a unitary structure, wherein the coating remains stationary on the staple.

Regarding claim 10, it would have been obvious to one having ordinary skill in the art to have provided Dennis' invention including a coating thickness range from about 0.001 inches to 0.050 inches as a matter of design choice.

4. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dennis'604 as applied to claim 8 above, and further in view of Kish et al. (US Pat. 5,441,373). Dennis'604 does not specifically state that the staples are made of steel. However, Kish'373 teaches a staple made of steel (col. 1, lines 34-35) for the purpose of providing a staple with the required hardness and stiffness properties. In view of Kish'373, it would have been obvious to one having ordinary skill in the art to have modified Dennis' invention as modified by Kish'373 having a staple made of steel in order to provide a staple with the required hardness and stiffness properties assuring the penetration and fastening of the staple into a substrate.

Regarding claim 12, Dennis'604 does not disclose that each free end of the staple terminates in an angled cut. However, Kish'373 teaches a staple with angled cut free ends for the purpose of facilitating the penetration of the staple into a substrate. In view of Kish'373, it would have been obvious to one having ordinary skill in the art to have

provided Dennis' invention including a staple with angled cut free ends in order to facilitate the penetration of the staple into a substrate.

***Response to Arguments***

5. Applicant's arguments have been fully considered but they are not deemed persuasive.
6. Applicant contends that Kish'405 does not show or suggest uniformly coated fasteners, or fasteners that are individually uniformly coated to form a unitary structure as between each individual fastener and the coating. However, as can be seen in Figs. 9-13, Kish'405 teaches the process step of feeding individual and separated wires "12" to a coating station "14". It is deemed that Kish'405 fasteners are formed from a staple body or wire "12" being individually and uniformly coated, thereby forming a unitary structure as between each individual fastener and the coating.
7. For the reasons above, the ground of rejection are deemed proper.
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 703-305-8205. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 703-308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SCOTT A. SMITH  
PRIMARY EXAMINER